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February 22, 2006

To	Company	Fax	Phone
Mail Stop Petitions	U.S. PTO	571.273.8300	

From: Lester L. Hewitt
Total Pages: 15
Direct Dial: 713.220.5851
Re: Serial No. 07/032,041 Applicant: Ching-Wu Chu

Message: Attached for filing in the U.S. PTO are the following documents:

1. Petition Under 37 CFR § 1.183 to Suspend the Rules;
2. Exhibit A: IDS Submitted After Payment of Issue Fee on January 5, 2006 with:
 - a. PTO/SB/08B (07-05) (Substitute for form 1449/PTO);
 - b. 2/16/2006 letter to Ru-Ling Meng, Ph.D. from Akin Gump Strauss Hauer & Feld;
 - c. 2/16/2006 letter to Pei-Herng Hor, Ph.D. from Akin Gump Strauss Hauer & Feld;
 - d. 2/15/2006 email from Prof. Ching-Wu to Lester L. Hewitt enclosing email dated 2/15/2006;
3. Petition Fee Under CFR 1.17(f), (g) & (h) Transmittal (in duplicate).

053451.0001/

Floor: 42nd

☒ Return fax via Interoffice Mail

Sender's email: lhewitt@akingump.com

Secretary: Sandy Sutherland

☐ Hold fax for pickup

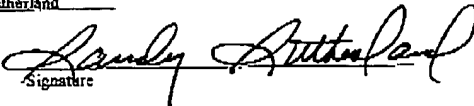
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<u>CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. 1.8(a)</u>	
I hereby certify that this correspondence is being facsimile transmitted to the USPTO (571-273-8300) on the date indicated below.	
Name of Person Signing Certificate:	<u>Sandy Sutherland</u>
February 22, 2006 Date	 Signature

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MAIL STOP PETITIONS**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Applicant:	§	Conf. No.:	6143
	§		
CHING-WU CHU	§		
	§		
Filed: March 26, 1987	§	Art Unit:	1751
	§		
Serial No.: 07/032,041	§	Examiner:	Mark Kopec
	§		
For: SUPERCONDUCTIVITY IN	§	Docket No.:	CIP-81297
SQUARE-PLANAR COMPOUND	§		
SYSTEMS	§	Customer No.:	01200

PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND THE RULES

On January 5, 2006, the issue fee was paid in this patent application, allowing it to proceed to issuance after pending almost 19 years. Subsequent to payment of the issue fee, the University of Houston, Assignee of record of this patent application, was notified by two individuals, Pei-Herng Hor and Ru-Ling Meng, employees of Assignee since prior to the filing date of this application on March 26, 1987, that they claimed co-inventorship of this patent application. Applicant and its Assignee (collectively "Assignee") has a duty to notify the U.S. Patent and Trademark Office of information material to patentability under 37 C.F.R. § 1.56. Assignee has begun a diligent investigation into these claims. At this time, Assignee has not been able to determine if this claim is material to patentability, however, Assignee has filed the Information Disclosure Statement under 37 C.F.R. § 1.97(i) of Exhibit A to assure this information will be placed in the file.

According to Assignee's understanding of 37 C.F.R. § 1.313, the existence of this claim of inventorship does not meet any of the express conditions of § 1.313(c) for withdrawal of this application from issue, including filing of an RCE, which does not apply to patent applications

Serial No. 07/032,041
Petition to Suspend the Rules

such as this filed before June 8, 1995. A continuation of this application cannot be filed without loss of the entire patent life, also due to the age of the application. Therefore, Assignee petitions the U.S. Patent and Trademark Office under 37 C.F.R. § 1.183 to suspend the rules, (specifically, Assignee requests suspension of 37 C.F.R. § 1.313(c) and any other rules) withdraw this application from issue, and thereafter hold this application in suspension for a period of six months from grant of this Petition. This period of suspension will allow the Assignee sufficient time to complete its investigation to determine whether inventorship of this patent application should be corrected and file for any necessary correction of inventorship under 37 C.F.R. § 1.48.

If during this period of suspension, Assignee files for a correction of inventorship, the Director can remove the suspension to allow examination of this correction of inventorship. If Assignee makes no attempt to correct inventorship during the period of suspension, then the suspension can be removed and the application proceed to issue.

A suspension of rules under § 1.183 is appropriate in "an extraordinary situation" "when justice requires." The unfortunate timing of this claim (made after nearly two decades of pendency and payment of the issue fee) by the alleged co-inventors Pei-Herng Hor and Ru-Ling Meng places the Assignee in an unusual position. As the Director knows, there are limited ways in which an Assignee can correct inventorship, including:

1. During the application stage, under 37 C.F.R. § 1.48, pursuant to 35 U.S.C. § 116;
2. After issuance of the patent, through a certificate under 35 U.S.C. § 256 and 37 C.F.R. § 1.324 from the Director of the U.S. Patent and Trademark Office correcting the error in inventorship;
3. After issuance of the patent, through a reissue proceeding under 35 U.S.C. § 251 in the U.S. Patent and Trademark Office;
4. After issuance of the patent, through a court-ordered correction, with the Director subsequently issuing a certificate accordingly under 35 U.S.C. § 256.

Serial No. 07/032,041
Petition to Suspend the Rules

Correction of inventorship of a pending application can be made, even if a joint inventor refuses to sign a corrected declaration. However, if correction of inventorship is made to an issued patent under 37 C.F.R. § 1.324, declarations of agreement of all named and unnamed inventors must be filed. *See* M.P.E.P. § 1481.02 describing the differences between 35 U.S.C. § 256 and 35 U.S.C. § 116. Assignee cannot yet determine if there is a need to correct inventorship and, if a need to correct inventorship is determined, Assignee cannot estimate the likelihood that all parties will agree. Correction of inventorship through reissue is not only a lengthy process, but also under 35 U.S.C. § 251, admission must be made that the patent is wholly or partly inoperative or invalid, which may be an unnecessarily prejudicial statement. Similarly, seeking correction of inventorship through litigation instituted after issuance of the patent can be drawn out and costly. In that regard, Assignee notes that claimants Pei-Herng Hor and Ru-Ling Meng are employees of the University, but due to the potential for conflict, attorneys for the University are adverse to the claimants. Thus, the claimants must seek their own counsel.

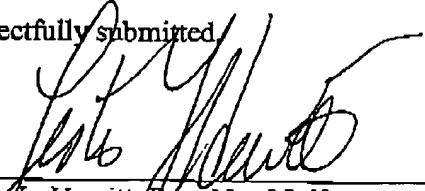
Finally, the claims of this patent application are directed to superconductive compositions, which are to be accorded "special status" under M.P.E.P. § 708.02 IX. While this provision is directed to accelerating the processing of patent applications, it is also directed to the "adjudication of disputes involving superconductivity technologies. . . ." Therefore, special status should be afforded this application.

In view of the extraordinary timing of this claim, the interest of the Assignee in having this patent application issue after investigation of this inventorship dispute, and the interest of the public in patents directed to superconductive material, Assignee submits that justice requires that the application be withdrawn from issue, and held in abeyance or suspension for a reasonable period to allow Assignee to conduct an investigation and make necessary corrections, if any, to inventorship.

Serial No. 07/032,041
Petition to Suspend the Rules

A fee as required in 37 C.F.R. § 1.17(f) is enclosed.

Respectfully submitted,



Date: February 22, 2006

Lester L. Hewitt, Reg. No. 25,685

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FEB 22 2006

PTO/SB/17p (11-05)

Approved for use through 07/31/2007. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1996, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FEE Under 37 CFR 1.17(f), (g) & (h) TRANSMITTAL (Fees are subject to annual revision) Send completed form to: Commissioner for Patents P.O. Box 1450, Alexandria, VA 22313-1450	Application Number	07/032,041
	Filing Date	March 26, 1987
	First Named Inventor	Ching-Wu Chu
	Art Unit	1751
	Examiner Name	Mark Kopec
	Attorney Docket Number	CIP-81297 H053451.1US

Enclosed is a petition filed under 37 CFR 1.183 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 400.00 is enclosed.

This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(f), see form PTO/SB/17i.

Payment of Fees (small entity amounts are NOT available for the petition fees)

☒ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 16-2435 :
☒ petition fee under 37 CFR 1.17(f), (g) or (h) ☒ any deficiency of fees and credit of any overpayments
 Enclose a duplicative copy of this form for fee processing.

☐ Check in the amount of \$ _____ is enclosed.

☐ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462

For petitions filed under:

- § 1.36(a) - for revocation of a power of attorney by fewer than all applicants
- § 1.53(e) - to accord a filing date.
- § 1.57(a) - to accord a filing date.
- § 1.182 - for decision on a question not specifically provided for.
- § 1.183 - to suspend the rules.
- § 1.379(e) - for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) - to accord a filing date to an application under § 1.740 for extension of a patent term.

Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463

For petitions filed under:

- § 1.12 - for access to an assignment record.
- § 1.14 - for access to an application.
- § 1.47 - for filing by other than all the inventors or a person not the inventor.
- § 1.59 - for expungement of information.
- § 1.103(a) - to suspend action in an application.
- § 1.136(b) - for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 - for review of refusal to publish a statutory invention registration.
- § 1.296 - to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 - for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(e) - for patent owner requests for extension of time in *ex parte* reexamination proceedings.
- § 1.956 - for patent owner requests for extension of time in *inter partes* reexamination proceedings.
- § 5.12 - for expedited handling of a foreign filing license.
- § 5.15 - for changing the scope of a license.
- § 5.25 - for retroactive license.


Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464

For petitions filed under:

- § 1.19(g) - to request documents in a form other than that provided in this part.
- § 1.84 - for accepting color drawings or photographs.
- § 1.91 - for entry of a model or exhibit.
- § 1.102(d) - to make an application special.
- § 1.138(c) - to expressly abandon an application to avoid publication.
- § 1.313 - to withdraw an application from issue.
- § 1.314 - to defer issuance of a patent.


 Signature
 Lester L. Hewitt

Typed or printed name


 Date

25,688

Registration No., if applicable

This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 5 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.